



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,206	11/18/2003	Barry Appelman	06975-374001	2250

26171 7590 09/27/2007
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

WALSH, JOHN B

ART UNIT	PAPER NUMBER
----------	--------------

2151

MAIL DATE	DELIVERY MODE
-----------	---------------

09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,206

Applicant(s)

APPELMAN ET AL.

Examiner

John B. Walsh

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/8/04, 9/7/2006</u> . | 6) <input checked="" type="checkbox"/> Other: <u>5/22/2007, 9/10/2007</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 37-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear drawn to computer software, which is non-statutory subject matter. The claims do not recite an appropriate computer readable storage medium or the computer structure for enacting the computer program. Furthermore the claim recites a propagated signal that is also non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-49 (claims 37-49 as best understood) are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,430,604 to Ogle et al.

As concerns claims 1 and 37, a notification system that reconfigures an electronic message to effect an enhanced notification, the system comprising: an input interface configured to receive at least one electronic message created by or on behalf of a message source for delivery to an intended recipient (figure 5a; 500); a matching engine configured to

Art Unit: 2151

determine whether the electronic message corresponds to a predetermined definition of an enhanced notification (figure 5a, 515); a user information store configured to store information related to the intended recipient (figure 5a,); and an enhancement engine configured to reconfigure the electronic message to the enhanced notification if the information of the user information store indicates that the intended recipient is subscribed to receive the enhanced notification (figure 5a, 540).

As concerns claims 2 and 38, wherein the user information store comprises a subscriber engine configured to store subscriber information associated with the intended recipient (figure 5a; registry; column 3, lines 7-50).

As concerns claims 3 and 39, wherein the subscriber engine is configured further to provide the intended recipient with an opportunity to subscribe to the enhanced notification if the intended recipient is not subscribed already (column 7, lines 35-45-user can change options).

As concerns claims 4 and 40, wherein the user information store comprises presence information related to the intended recipient (figure 3).

As concerns claims 5, 26 and 41, wherein the presence information includes information related to online presence of the intended recipient at a time at which the enhancement engine is preparing to provide the enhanced notification to the intended recipient (figure 3).

As concerns claims 6 and 42, wherein the information related to the current online presence of the intended recipient includes information indicating a delivery mechanism associated with the online presence of the intended recipient at a time at which the enhancement engine is preparing to provide the enhanced notification to the intended recipient (figure 3).

Art Unit: 2151

As concerns claims 7 and 43, wherein the presence information includes information indicating that the intended recipient physically is present within a predefined range of one or more of the delivery mechanisms potentially available to the intended recipient at a time at which the enhancement engine is preparing to provide the enhanced notification to the intended recipient (figure 3).

As concerns claims 8, wherein the predetermined definition of the enhanced notification comprises a system definition (figure 3).

As concerns claim 9, wherein the predetermined definition of the enhanced notification further comprises a preference of the intended recipient (figure 3).

As concerns claim 10, wherein the predetermined definition of the enhanced notification comprises a data structure (column 7, lines 64-65) configured to accommodate a system definition and a preference of the intended recipient.

As concerns claims 11 and 29, wherein the enhanced notification includes a cascaded delivery definition (column 3, lines 39-40).

As concerns claims 12, 30 and 44, wherein the cascaded delivery definition lists several delivery mechanisms (figure 3-multiple delivery mechanisms), and wherein the enhancement engine is configured further to use the presence information to select a delivery mechanism from within the cascaded delivery definition that appears available to provide the enhanced notification to the intended recipient without significant delay (figure 3).

As concerns claim 13, wherein the cascaded delivery definition includes an instant message delivery mechanism (403).

As concerns claim 14, wherein the cascaded delivery definition includes an email delivery mechanism (332).

As concerns claims 15, 31 and 45, wherein the enhanced notification includes a lifespan (column 7, lines 34-38; figure 3).

As concerns claims 16, 32 and 46, wherein the lifespan comprises a time period during which information of the enhanced notification reasonably may be expected usefully to inform an action of the intended recipient (figure 3).

As concerns claims 17, 33 and 47, wherein the enhancement engine is configured further to vacate the enhanced notification provided to the intended recipient when the intended recipient does not access the enhanced notification during the lifespan (figure 5F1).

As concerns claims 18, 34 and 48, wherein the enhancement engine is configured further to provide a plurality of instances of the enhanced notification to the intended recipient based on the lifespan and to sense that an instance of the enhanced notification has been accessed by the intended recipient (figure 5F2), and, in response, to vacate an instance of the enhanced notification not yet accessed by the intended recipient (column 11, lines 45-50).

As concerns claims 19 and 36, wherein the enhanced notification is configured to provide the intended recipient with access to the electronic message by interacting with an aspect of the enhanced notification (user interacts with device where message was received).

As concerns claims 20, 36 and 49, wherein the system is further configured to update or eliminate a related instance of the enhanced notification based on the user interacting with the enhanced notification (column 7, lines 35-45).

As concerns claim 21, wherein the matching engine is configured further to match the electronic message to the predetermined definition of the enhanced notification based on a source and a content of the electronic message (figure 5a).

As concerns claim 22, further comprising a notification archive (registry) configured to store a plurality of enhanced notifications and to record historical information related to at least one of the enhanced notifications.

As concerns claim 23, a method of reconfiguring an electronic message to effect an enhanced notification, the method comprising: receiving an electronic message of a first type; detecting at least one of a message source, a message destination, and message content characteristics; accessing criteria that is stored and related to at least one of message source, message destination, and message content characteristics; evaluating whether or not to reconfigure the electronic message as a second type message based on at least one of the message source, the message destination, and the message content characteristics determined; and reconfiguring the electronic message when one of the message source, the message destination and the message content characteristics match the accessed criteria (figure 5a).

As concerns claim 24, the method of claim 23 further comprising: accessing stored criteria related to a subscriber status; evaluating whether or not to reconfigure the electronic message as a second type of message based on the determined subscriber status; and reconfiguring the electronic message only when the subscriber status indicates that an intended recipient of the electronic message is subscribed (figure 3; figure 5a).

Art Unit: 2151

As concerns claim 25, the method of claim 23 further comprising: determining presence information of an intended recipient; and reconfiguring the electronic message based on the presence information of the intended recipient (figure 3).

As concerns claim 27, the method of claim 23 further comprising: accessing stored criteria related to a system definition; evaluating whether or not to reconfigure the electronic message as a second type message based on the determined system definition; and reconfiguring the electronic message based on the system definition (figure 3, figure 5a).

As concerns claim 28, the method of claim 23 further comprising: accessing stored criteria related to a user preference; evaluating whether or not to reconfigure the electronic message as a second type message based on the determined user preference; and reconfiguring the electronic message based on the user preference (figure 3, figure 5a).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892. USPN 6,208,896 discloses expiration of a time period.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John B. Walsh
Primary Examiner
Art Unit 2151